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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------------|
| 09/457,109 | 12/07/1999 | DARRYL E. RUBIN | 03797.81487 | 7310 |
| 22907 7590 12/11/2007 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051 | | | EXAMINER NGUYEN, MAIKHANH | |
| | | | ART UNIT 2176 | PAPER NUMBER |
| | | | MAIL DATE 12/11/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/457,109

Applicant(s)

RUBIN ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-18 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to Appeal Brief filed 09/10/2007.

Claims 2-18 and 21 are presented for examination. Claims 2-5 and 21 are independent claims.

In view of the Appeal Brief filed on 09/07/2007, PROSECUTION IS HEREBY REOPENED. A new ground of rejection s set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.


DOUG HUTTON
SUPERVISORY PATENT EXAMINER

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2, 3, and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claims 2, 3, and 21 recite a computer user interface, which is merely a software component, i.e., computer program per se. Such claimed matter, which is non-functional descriptive material per se, is not statutory. Such claimed computer program does not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer's program's functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the program itself is not a process, without the computer-readable medium needed to realize the computer's functionality, it is regarded as nonstatutory functional descriptive material. Therefore, the claimed invention is directed to non-statutory subject matter.

Claims which are broad enough to read on statutory subject matter or on non-statutory subject matter are considered non-statutory. Cf. *In re Lintner*, 458 F.2d 1013, 1015, 173 USPQ 560, 562 (CCPA 1972) (“Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter.”) During prosecution, applicant can amend to limit the claims to statutory subject matter.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “the linked-to document page” (claim 4, lines 6-7) lacks antecedent basis. The claim has no “a linked-to document page” term that defines or supports the given reference.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2, 3, 5, 14-16, and 21 are rejected under 35 U.S.C. 102(e) as being anticipating by **Price et al.** (US 6766494, filed June 15, 1998).

As to claim 21:

Price teaches a computer interface (*see the Abstract*) comprising:

- a plurality of document pages (*col.3; lines 35-43, col.4; lines 56-42; col.5; lines 4-15 -> notebook pages 50, 52, and 54*); and
- at least two of the document pages including links (*see the Abstract, col. 3, lines 35-47, col.5, lines 16-49, col.10, lines 42-50 ->link documents ... creates "ink anchors" to help readers create idiosyncratic many-to-many links*), one of the links having a property that indicates a display format for the link (*col.10, lines 6-22*), wherein the link relates a spot in a document page with an executable object

(col.3, lines 35-43, col. 5, lines 3-49 -> by circling and drawing a line to the destination. The copy 58 and the original 60 will be automatically linked together. Thus, annotations with surrounding text can be converted into notes ... computes links between the ink anchors by grouping ink marks together that have similar morphological or spatial characteristics).

As to claim 2:

The rejection of claim 21 above is incorporated herein in full. Additionally, Price teaches the display format of the link is based upon an examination of the content of a target document associated with the link *(col. 6, line 3- col. 7, line 23 and figs.4, 5B -> looking up the link target that corresponds to the location of the tap using the link database. If the link database includes a link that corresponds to the location of the tap then the control routine of the system determines a corresponding link in the link database. The control routine then displays the list of link targets as "annotations in context" ... to view a particular link target).*

As to claim 3:

The rejection of claim 21 above is incorporated herein in full. Additionally, Price teaches the links has a property indicating the display update latency of the links *(col.7, line 24- col. 8, line 11 and see also figs 5A-B and 6A-6B -> user can remove an unintended ink anchor by erasing the anchor. Therefore, the user can correct erroneous ink anchor matches by erasing the anchor, rewriting the ink, and circling it again ... removes all ink*

strokes in the link target from the ink annotation database ... routine removes the link target from the link ... the control routine removes the link from the link database ... the control routine updates the display).

As to claim 5:

Refer to the discussion of claim 21 above for rejection.

As to claim 14:

Price teaches using heuristics to automatically provide a set of command choices to the user (*col.5, lines 16-49*).

As to claim 15:

Price teaches at least one command in the set of command choices based upon analysis of the user's current document context (*col.5, lines 16-49*).

As to claim 16:

Price teaches at least one command in the set of command choices based upon a set of commands recently invoked by the user (*col.3, lines 24-34*).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4, 6-13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Price** in view of **Hsu et al.** (US 6549220, filed 06/1999).

As to claim 4:

The rejection of claim 21 above is incorporated herein in full. Additionally, claim 4 recites “*navigating to a document page and display the document page in a first display format; and navigating to the link-to document page and display the document page in a second display format, the second display format being different than the first display format.*”

Hsu teaches navigating to a document page and display the document page in a first display format; and navigating to the link-to document page and display the document

page in a second display format, the second display format being different than the first display format (*col. 5, line 7-col.6, line 48*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Price with Hsu because it would have allowed the use of the flexibility of free-form ink to make anchors meaningful; it would also allowed a user to create links more quickly and easily.

As to claim 6:

Hsu teaches displaying, in a display frame associated with a link in a linked-from document page, information about a linked-to document (*col.1, line 58 - col.2, line 47*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Price with Hsu because it would have allowed the use of the flexibility of free-form ink to make anchors meaningful; it would also allowed a user to create links more quickly and easily.

As to claim 7:

Hsu teaches displaying, in a display frame associated with a link in a linked-from document page, content of a linked to document (*col.1, line 58 - col.2, line 47*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Price with Hsu because it would have allowed the use of the

flexibility of free-form ink to make anchors meaningful; it would also allowed a user to create links more quickly and easily.

As to claim 8:

Hsu teaches updating the display of the linked-to content at a rate specified by a property of the link linking the linked-from and linked-to document pages (*col.4, line 61- col.5, line 45*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Price with Hsu because it would have allowed the use of the flexibility of free-form ink to make anchors meaningful; it would also allowed a user to create links more quickly and easily.

As to claim 9:

Hsu teaches using heuristics to automatically provide most-likely-to-use links to additional material (*col.1, lines 33- 46*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Price with Hsu because it would have allowed the use of the flexibility of free-form ink to make anchors meaningful; it would also allowed a user to create links more quickly and easily.

As to claim 10:

Hsu teaches providing at least one of the most-likely-to-use links based upon documents previously navigated to by the user (*col.5, lines 7- col.6, line 2*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Price with Hsu because it would have allowed the use of the flexibility of free-form ink to make anchors meaningful; it would also allowed a user to create links more quickly and easily.

As to claim 11:

Hsu teaches providing at least one of the most-likely-to-use links based upon documents having subject matter similar to a document being viewed by the user (*col.5, lines 7- col.6, line 2*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Price with Hsu because it would have allowed the use of the flexibility of free-form ink to make anchors meaningful; it would also allowed a user to create links more quickly and easily.

As to claim 12:

Price teaches providing at least one of the most-likely-to-use links based upon documents created by an author who is the same as an author of a document being viewed by the user (*col.5, lines 4-49*).

As to claim 13:

Hsu teaches providing at least one of the most-likely-to-use links based upon documents created during a first time period substantially the same as a time period during which a document being viewed by the user was created.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Price with Hsu because it would have allowed the use of the flexibility of free-form ink to make anchors meaningful; it would also allowed a user to create links more quickly and easily.

As to claim 17:

Hsu teaches at least one command in the set of command choices based upon commands the user has invoked most frequently in the past from contexts substantially the same as the user's current document context (*col. 6, line 13-col.7, line 27*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Price with Hsu because it would have allowed the use of the

flexibility of free-form ink to make anchors meaningful; it would also allowed a user to create links more quickly and easily.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Price** in view of **Fogg et al.** (US 6321242, filed 02/06/1998).

As to claim 18:

Fogg teaches displaying at least one second link within an e-mail message document page, the at least one second link, upon activation, causing command code to be executed to perform an operation selected from the group consisting of: reply, reply to all, forward, and delete (*see the Abstract, col. 6, line 42-57, and fig. 7 & associated text*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Price with Fogg because it would have allowed web sites to easily update hypertext links in documents on feeder sites to point to new locations for a receiving site document when the document has been relocated.

Response to Arguments

8. Applicant's arguments with respect to claims 2-18 and 21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

Contact information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MN

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER